



PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Upvan NARANG et al.

Group Art Unit: 1615

Application No.: 09/430,177

Examiner: T. WARE

Filed: October 29, 1999

Docket No.: 100448.01

For: ADHESIVE APPLICATOR TIP WITH A POLYMERIZATION INITIATOR,  
POLYMERIZATION RATE MODIFIER, AND/OR BIOACTIVE MATERIAL

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS**

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

In reply to the combined Restriction and Election Requirements mailed January 29, 2003, Applicants provide the following comments.

Claims 1-51 and 76-144 are pending herein. Claims 1-51 and 76-144 are subject to a Restriction and an Election of Species Requirement.

I. The Restriction and Election of Species Requirements are Improper

Initially, Applicants respectfully submit that both the Restriction Requirement and the Election of Species Requirement are clearly, and should be withdrawn. The Requirements are improper at least because there would be no burden on the Examiner to search and examine the full scope of the pending claims.

Applicants respectfully assert that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants. This is evidenced by the fact that the Patent Office has already searched and

examined the full scope of all of the original claims. The application was already subjected to a first Restriction Requirement, mailed January 3, 2001, to which Applicants filed a response on January 24, 2001. Based on Applicants' response, the Examiner previously indicated that the original Restriction Requirement was withdrawn, and all of the pending claims were examined on the merits. See April 6, 2001, Office Action at page 2.

Since that first Restriction Requirement, the Patent Office has issued three Office Actions, all of which addressed all of the pending claims on the merits. See Office Actions dated April 6, 2001, October 9, 2001, and March 13, 2002. Applicants timely responded to each of the Office Actions and, in response to an Advisory Action, filed a Request for Continued Examination on November 13, 2002.

As evidenced by the already lengthy prosecution history, the Patent Office has already searched and examined all of the pending claims, on at least three separate occasions. Because all of the claims have been searched and examined, there should be no further substantial burden on the Examiner to continue to search and examine the entire claimed invention. Maintaining the Restriction and Election of Species Requirements would thus only work a manifest injustice upon Applicants. The Requirements should thus be withdrawn.

## II. Response to Restriction Requirement

In response to the Restriction Requirement, Applicants elect Group I, claims 1-25, 50-51, and 111-121, directed to an applicator tip and methods for making an applicator tip.

For at least all of the reasons described above, the claims of Groups I-III are very interrelated, and have and can be examined together. Search and examination of any one group of claims will thus at least overlap, and in some cases fully encompass, the search for the subject matter of other groups of claims. Accordingly, in the interest of advancing prosecution and reducing the burdens upon the Patent Office and Applicants', the Restriction Requirement between all of Groups I-III should be withdrawn.

According to MPEP §803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present application, Groups I to III are directed to inter-related subject matter, as evidenced by the inter-dependency of claims in the separate groups. Accordingly, search and examination of the subject matter of any one Group of claims, and particularly of elected Group I, would encompass a search for the subject matter of Groups II and III, and any additional search would not impose a serious burden upon the Examiner.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group I, the further search and examination of Groups II and III would not place a serious burden upon the Examiner.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

### III. Response to Election of Species Requirement

In the event Applicants elected Group I, the Office Action requires election between Species (a)-(d). In response to the Election of Species Requirement, Applicants hereby elect Species (c), i.e., where the agent is a polymerization initiator. This election is made with traverse.

In further response to the Election of Species Requirement, Applicants respectfully assert that at least claims 1 and 50 are generic to the elected species. Applicants respectfully assert that at least claims 1-3, 5-12, 15-25, 50-51, and 111-121 read on the elected species.

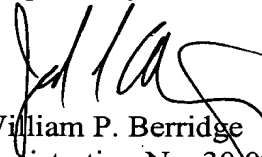
Applicants traverse the election of species requirement on the ground that the generic claims are not so broad as to place an undue burden on the Patent Office to search and examine the full scope of the claims. Rather, Applicants respectfully asserts that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants. This is evidenced by the fact that the Patent Office has already searched and examined the full scope of all of the original claims, as discussed above.

Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

IV. Conclusion

Early and favorable consideration of the application are respectfully requested. Should the Examiner have any questions regarding the application, or any suggestions to expedite prosecution, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

  
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Date: February 28, 2003

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